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10/782,472	02/18/2004	Jonathan Dale	073338.0135 (02-53312 FLA	4871
5073	7590	09/01/2010	EXAMINER	
BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			McCORMICK, GABRIELLE A	
			ART UNIT	PAPER NUMBER
			3629	
			NOTIFICATION DATE	DELIVERY MODE
			09/01/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptomail1@bakerbotts.com

glenda.orrantia@bakerbotts.com

Office Action Summary

Application No.

10/782,472

Applicant(s)

DALE, JONATHAN

Examiner

GABRIELLE MCCORMICK

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-9, 12-17 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-9, 12-17 and 20-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This action is in reply to the amendment filed on August 16, 2010.
2. Claims 17 and 25 have been amended.
3. Claims 1, 4-9, 12-17 and 20-25 are currently pending and have been examined.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 25 contain means (or step) plus function limitations that invoke 35 U.S.C. 112, sixth paragraph. However, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function. The "means" appears to be the organization agent which is a software program, therefore the means may be interpreted to be software per se.
6. Applicant is required to:
 - (a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or
 - (b) Amend the written description of the specification such that it clearly links or associates the corresponding structure, material, or acts to the claimed function without introducing any new matter (35 U.S.C. 132(a)); or

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- (c) State on the record where the corresponding structure, material, or acts are set forth in the written description of the specification that perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.
7. Applicant has argued that the "specification of the current application discloses an algorithm for which a processor is programmed to execute" and points to the flowchart of Fig. 4.
8. The Examiner does not find any reference to a processor programmed to execute an algorithm and maintains that the means is a software program, not any underlying structure, and therefore is software *per se*.
9. The Examiner is persuaded by Applicants arguments regarding the previous rejection under 112, first paragraph and notes that support for techniques for interfacing with feature interfaces is provided on page 16, lines 20-23. The rejection is withdrawn.
10. Accordingly, Applicant's arguments regarding the rejection under 112, second with respect to feature interfaces are also persuasive. The previous rejection is withdrawn.

Claim Rejections - 35 USC § 101

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

12. Claim 25 are rejected under 35 U.S.C. 101 because they lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 36 USC 101. They are clearly not a series of steps or acts (i.e., a process) not are they a combination of chemical compounds (i.e., composition of matter). As such, they fail to fall within a statutory category. They are, at best, function descriptive material *per se*.

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13. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, (33 F.3d at 1360, 31 USPQ2d at 1759). When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994).
14. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").
15. Applicant argues that because the claim includes recitations of structure that the claim constitutes a machine or manufacture. The Examiner disagrees in that the system claim is drawn to various "means for" which the specification has failed to associate with structure that performs the acts. The "means for" are understood to be directed to software *per se*, thus the system is understood as a recitation of various software programs that perform the establishing, accessing, communicating, determining and ranking steps.
16. The Examiner thanks the Applicant for the amendment to claim 17 which overcomes the previous rejection. The rejections to claims 17 and 20-24 are withdrawn.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. **Claims 1, 4-7, 9, 12-15, 17, 20-23 and 25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Das et al. (US Pub. No. 2003/0023499, hereafter referred to as "Das") in view of Vashistha et al. (US Pub. No. 2001/0051913, hereafter referred to as "Vashistha") in view of Solomon (US Pub. No. 2002/0046157).
19. **Claims 1, 9, 17 and 25:** Das discloses
- *a plurality of business function requirements;* (P[0047]: "short or long term strategic purchasing policy rules")
 - *accessing a service registry of a plurality of service providers coupled to a communications network;* (P[0065])
 - *for each of the identified service providers:*
 - *determine feature interfaces for interacting with the service provider; the service provider identifying at least techniques for interfacing with the feature* (P[0057]: the invention makes use of information indicating the interoperability mechanisms (e.g. negotiation protocols, etc.) that the vendor supports. The interoperability mechanisms are an example of feature interfaces. P[0058]: the system obtains interoperability mechanism information from the UDDI of businesses (thus feature interfaces are determined); the purchasing system sends a specification of desired products to a shopbot service that returns information to the purchasing system regarding pricing, availability, delivery time, etc. that was gathered from multiple vendors by accessing vendor websites and processing the information therein.

P[0059]: system automatically negotiates purchasing transactions after examining (i.e., interfacing with) on-line catalog (i.e., a feature) NOTE: Applicant's specification does not describe what the "techniques" for interfacing comprise, therefore, the Examiner understands a technique to be any means of interacting with a feature.

- *accessing at least one of the feature interfaces of the service provider to determine a plurality of service descriptors describing a service provided by the service provider;* (P[0068] negotiations are conducted using the internal rules and parameters where price and time that a product is needed are factors that are negotiated, therefore, in order to negotiate around these factors, the service provider must at least have service descriptors that disclose pricing and availability. P[0050]: parameters, including price, quantity, delivery times and quality measures are used to negotiate the purchase from sellers, therefore, negotiation involves determining descriptors provided by the provider. P[0052]: vendors are compared based on price and quality, thus, price and quality are disclosed as descriptors.)
- *determining whether the service provider is satisfactory based on if the service descriptors satisfy at least a portion of the business function requirements;* (P[0047]: rules include rank ordering for calculating tradeoffs among different product or vendor attributes and rank ordered lists of preferred vendors (i.e., satisfactory) and P[0052]).
- *negotiating a plurality of variable service descriptors* (P[0050]: Das discloses parameters for negotiating the purchases from sellers using variable service descriptors, including price, quantity, allowable substitutions, order size and delivery times)
- *ranking each of the satisfactory service providers based on the service descriptors from each of the satisfactory service providers.* (P[0047]: rules include rank ordering for calculating tradeoffs among different product or vendor attributes (i.e., service descriptors) and rank ordered or weighted lists of preferred vendors.)
- *authorizing performance of the service* (P[0073]: purchase order is transmitted to selected supplier, thus a third feature interface is inherent in the transmission of the PO.).

20. Das does not explicitly disclose whether a feature interface is a first, second or third, however, Das discloses an automated system over a network, such as the Internet, that includes vendor selection (determination of service descriptors describing a service is inherent in vendor selection); negotiation (P[0043]) and transmission of a PO (authorization) (P[0073]). Whether a feature interface is first, second or third is **nonfunctional descriptive data** and is not functionally involved in the steps recited. **The determination of service descriptors, negotiation and authorization would be performed regardless of the description of the interface.** Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
21. Das does not explicitly disclose *establishing an organizational database maintaining at least one business function description comprising a business function indicator; using the business function indicator to identify a network address for each service provider each having a service indicator matching the business function indicator.*
22. Vashistha, however, discloses a registration module for buyers and providers that includes a buyer (i.e., organizational) database. Buyer and supplier profiles are entered such that the outsourcing system can suitably match buyers and providers, therefore, it is obvious that a business function indicator is disclosed that enables identification of the provider. (P[0036]); Buyers can be a department or entity within a company (P[0031]), therefore each entity will have a *business function indicator* such as the name of the department. Further, Vashistha discloses RFPs with requirements and specifications (i.e., *business function requirements*) (P[0037]: "categories of the outsourcing elements captured within the RFP module can include various types...", thus the RFP module stores this data. The matching module uses data and criteria from buyers to match to data captured from providers so to identify only those providers meeting a minimum level of matching. (P[0038]: this discloses the functionality of determining a satisfactory level based on business function requirements where the provider is identified by the

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business function description. A service provider's network address is identified such that notification of qualified providers can be made via e-mail (P[0038]).

23. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included an organizational database using business function indicators to identify a network address for each provider, as disclosed by Vashistha in the system disclosed by Das, for the motivation of providing a method that "enables buyers, i.e., companies that need IT projects and/or services implemented and completed, to obtain end-to-end knowledge and support to initiate, decide and implement IT projects and services with providers..." (Vashistha; P[0029]). Das discloses the system and methodology for automatically making operational purchasing decisions in a data network using purchasing rules that evaluate possible vendors to identify a set of vendors from which the product or service may be obtained, with a final selection for purchase from one or more vendors using rules, information about the vendors and the results of negotiations. (Das; P[0013]). Therefore, both Vashistha and Das aim to accomplish the objective of matching buyers and providers using rule based decision making systems and methodologies, thus it is obvious to expand Das to include the features of Vashistha.
24. Das does not disclose ranking based on the negotiations (and therefore ranking doesn't include the negotiated plurality of variable service descriptors).
25. Vashistha, however, discloses ranking bids (P[0066]) following a discussion and bidding module which provides a mechanism for facilitating the collaboration between buyers and providers to obtain an improved understanding of the RFP, thus ranking follows negotiation.
26. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included ranking prior to final selection, as disclosed by Vashistha, in the system of Das for the motivation of selecting a provider. Ranking is an old and well known form of aiding decision making and Das discloses that the selection may be based on the results of the negotiation, as well as other factors where the lowest price is not necessarily the basis for selection. (Das; P[0080]). By scoring and ranking, as disclosed by Vashistha, these other factors are accorded a role in the automated decision making process of Das. It then becomes obvious

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- to authorize performance of a service as disclosed by Das (P[0073]) by the highest ranking service provider. Das discloses authorizing the "selected" seller. The combination with Vashistha to rank makes it obvious that the selected seller would also be the highest ranking.
27. Das discloses that the system uses information indicating the interoperability mechanisms (feature interfaces) that the vendor supports (P[0057]) but does not disclose communicating with the service provide to determine feature interfaces.
28. Solomon, however, at claim 75, discloses a buyer's intelligent agent and seller's intelligent agent agreeing (i.e., communicating to each other) a programming language (i.e., an interface) for engaging in a negotiation (i.e., a feature).
29. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included communicating with the service provider to determine the feature interfaces, as disclosed by Solomon, in the system of Das for the motivation of providing participants in a business-to-business environment with fast and easy ways to make their programs communicate.
30. **Claims 4, 12 and 20:** Das discloses a plurality of deal parameters and a negotiation threshold (i.e., "maximum acceptable price") (P[0047-0048]) and performing a negotiation via a "back-and-forth sequence of offers and counteroffers" where each counteroffer is compared to rules to determine acceptability. (P[0068]).
31. **Claims 5, 13, and 21:** Das provides notification/authorization by transmitting purchase orders to the selected vendors. (P[0073]) but does not disclose a highest ranking provider.
32. Vashistha, however, discloses ranking bids (P[0066]) following a discussion and bidding module which provides a mechanism for facilitating the collaboration between buyers and providers to obtain an improved understanding of the RFP. (P[0064]. Vashistha also discloses providing a qualified list of providers following scoring and ranking, thus providing a notification identifying the highest ranking provider. (P[0063]).
33. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included ranking prior to final selection, as disclosed by Vashistha, in the system of Das for the motivation of selecting a provider. Ranking is an old and well known form of aiding

decision making and Das discloses that the selection may be based on the results of the negotiation, as well as other factors where the lowest price is not necessarily the basis for selection. (Das; P[0080]). By scoring and ranking, as disclosed by Vashistha, these other factors are accorded a role in the automated decision making process of Das.

34. **Claims 6, 14 and 22:** Das discloses retrieving a list of known vendors and additionally querying a directory to find new vendors to add to the list (P[0065]). Vendors are then negotiated with (P[0068]) until a selection is made and a purchase order transmitted (P[0073]). Das does not disclose a highest ranking between current and satisfactory service providers.
35. Vashistha, however, discloses matching buyers to both providers the buyer currently uses and with a global network of providers where both buyers and providers are notified. (P[0038]). Vashistha further discloses providers are scored and ranked and the results provided in a qualified list of providers. (P[0063]). It is inherent in ranking that a highest ranking provider is identified, and therefore a notification of such is generated with the qualified list in P[0063].
36. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included a highest ranking, as disclosed by Vashistha, in the system of Das for the motivation of for the motivation of selecting a provider. Ranking is an old and well known form of aiding decision making and Das discloses that the selection may be based on the results of the negotiation, as well as other factors where the lowest price is not necessarily the basis for selection. (Das; P[0080]). By scoring and ranking, as disclosed by Vashistha, these other factors are accorded a role in the automated decision making process of Das.
37. **Claims 7, 15 and 23:** Das provides notification/authorization by transmitting purchase orders (i.e., organization information) to the selected vendors. (P[0073]).
38. **Claims 8, 16 and 24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Das et al. (US Pub. No. 2003/0023499, hereafter referred to as "Das") in view of Vashistha et al. (US Pub. No. 2001/0051913, hereafter referred to as "Vashistha") in view of Solomon (US Pub. No.

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2002/0046157) in further view of Chun et al. (US Pub. No. 2002/0184527, hereafter referred to as "Chun").

39. **Claims 8, 16 and 24:** Das/Vashistha discloses the limitations of claims 7, 15 and 23. Das discloses evaluating vendors to identify a set of vendors from which a service can be obtained. (Abstract). Das does not disclose payroll management, employee, payment or banking information.
40. Chun, however, discloses that businesses outsource payroll management (P[0004]) that includes the exchange of data relating to human resources and payroll. (P[0025]). Data and information relating to employees, salaries (i.e., payment) and banking are inherently comprised in the data disclosed.
41. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included payroll management and data, as disclosed by Chun, in the system of Das for the motivation of providing an example of a service providing vendor.

Response to Arguments

42. Applicant's arguments filed August 16, 2010 have been fully considered but they are not persuasive.
43. Applicant argues that Das does not disclose the service provider identifying techniques for interfacing with the feature interfaces and states that although Das discloses that the invention "makes use of information indicating the interoperability mechanisms" that Das is silent about how such information is obtained.
44. Firstly, the Examiner maintains that Das at P[0057] discloses that the "invention may make use of information indicating the interoperability mechanisms (e.g., negotiation protocols, etc.) that the vendor supports". The Examiner therefore understands that the vendor (i.e., the service provider) identifies a technique for interfacing with a feature interface. For the system to have the information regarding the negotiation protocols that the vendor supports, the information must come from the vendor at some point in time.

45. Secondly, the Examiner notes that the rejection specified that Das discloses that the system uses information indicating the interoperability mechanisms (feature interfaces) that the vendor supports (P[0057]) but does not disclose communicating with the service provide to determine feature interfaces. As a result, Solomon, at claim 75, was cited to disclose a buyer's intelligent agent and seller's intelligent agent agreeing (i.e., communicating to each other) on a programming language (i.e., an interface) for engaging in a negotiation (i.e., a feature). Thus explicitly disclosing the service provider identifying a technique for interfacing with a feature interface through communication with the buyer's agent.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GABRIELLE MCCORMICK whose telephone number is (571)270-1828. The examiner can normally be reached on Monday - Thursday (5:30 - 4:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jamisue Plucinski can be reached on 571-272-6811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gabrielle McCormick/
Examiner, Art Unit 3629

/Jamisue A. Plucinski/
Supervisory Patent Examiner, Art Unit 3629